

HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

--29. The water-resistant cosmetic or dermatological sunscreen formulation

according to claim 12, which is in the form of an oil-in-water (O/W) emulsion.--

--30. The water-resistant cosmetic or dermatological sunscreen formulation

according to claim 12, which is in the form of a water-in-oil (W/O) emulsion.--

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time,

Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 12-28 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-20 of U.S. Patent No. 5,876,702. In response, Applicants again request that this issue be held in abeyance until allowable subject matter is indicated.

HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

Claims 12, 13, 16-21, 24-26 and 28 were rejected under 35 USC § 103(a) as being obvious over Allard et al. ("Allard"), U.S. Patent No. 5,616,331.

Claims 14, 15, 22, 23 and 27 were rejected under 35 USC § 103(a) as being obvious over Allard in view of either Billia et al. ("Billia"), U.S. Patent No. 5,486,353, in view of Robinson et al. ("Robinson"), U.S. Patent No. 5,306,485.

In response to both rejections based on Allard, Applicants again point out that Allard makes reference to a single sulfonic acid derivative as a sunscreen agent only in passing, and, hence, such compounds are not an essential component of Allard's invention. The Examiner says such sulfonic acid derivative is explicitly taught by Allard, and, therefore, is a part of Allard's invention. Nevertheless, because this is a non-essential part of Allard's invention, the motivation to select this derivative for use in Allard's formulations is questionable, let alone to select it for use in the instant formulations with the expectation that the properties thereof could be maximized as taught in the instant specification.

As taught in the instant specification on pages 2-5, it was completely surprising and unexpected that the advantageous properties of UV filter substances comprising one or more sulphonic acid or sulphonate groups could be maximized by including such UV filter substances in the formulations, as presently claimed. There is absolutely no teaching or suggestion of such a

HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

result in Allard alone or in combination with the other cited references. Accordingly, such result is surprising and unexpected, and, therefore, an objective indication of nonobviousness.

In any case, the rejections would not appear to be applicable to new claim 30 since the Examiner concedes Allard teaches oil-in-water emulsions.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

Claims 12-28 were rejected under 35 USC § 103(a) as being obvious over Gers-Barlag et al. ("Gers-Barlag"), U.S. Patent No. 5,725,844, in view of either Grollier et al. ("Grollier"), U.S. Patent No. 5,427,771, or Billia or Robinson.

In the paragraph bridging pages 8-9 of the Office Action dated May 2, 2001, the Examiner indicated that Gers-Barlag was cited as prior art under 35 USC § 102(e), and might be overcome by a showing of common ownership. In response, the undersigned hereby certifies that at the time the present invention was made, it was owned by Beiersdorf AG, the owner of Gers-Barlag, as evidenced by the common inventor, and the assignments of record both here and in Gers-Barlag.

HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

In any case, the rejection would not appear to be applicable to new claim 30 since the Examiner concedes Allard teaches oil-in-water emulsions.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By

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HEINRICH GERS-BARLAG ET AL.
USSN 08/987,468

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (8 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: March 17, 2003

By

Kurt G. Briscoe